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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,439	06/18/2001	David S. Huff	CAPITA 3.0-001	2784

530   7590   11/24/2004

LERNER, DAVID, LITTENBERG,
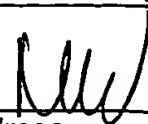KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER
PASS, NATALIE

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _18 June 2001_.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-34_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-34_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All   b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _6/18/01 & 3/28/03_.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 18 June 2001. Claims 1-34 are pending.

Specification

2. The claims are objected to because the lines are crowded too closely together, making reading and entry of amendments difficult. Substitute claims with lines one and one-half or double spaced on good quality paper are required. See 37 CFR 1.52(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 23 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

   (A) Claim 23 recites the limitation "the proposal format" in line 1; and

   (B) Claim 31 recites the limitation "said types of insurance" in lines 1-2.

There is insufficient antecedent basis for these limitations in the claims. For the purpose of finding art, Examiner interprets "the proposal format" to be the format of the offer of insurance.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6.   Claims 1-15, 19-23, 25-28, 31, 34 are rejected under 35 U.S.C. 102(b) as being

anticipated by Haught, et al., U.S. Patent Number 6,584,467.

(A)   As per claim 1, Haught teaches a method for automatically generating offers from

vendors (reads on insurance quotes) comprising:

preparing insurance profiles including information for one or more clients seeking

insurance coverage (Haught; see at least Figure 3, Item 390, column 4, lines 35-60);

storing the insurance profiles in an electronic database at one or more agency locations

(Haught; see at least Figure 1, Item 160, Figure 5, Item 545, column 3, lines 29-34, column 6,

lines 17-25);

extracting or gathering or obtaining one or more of the stored insurance profiles from

said electronic database (Haught; see at least column 1, line 65 to column 2, line 18, column 3,

lines 29-33, column 4, lines 12-17, column 6, lines 26-48);

translating or reformatting the extracted insurance profiles into a format recognizable by one or more underwriters or risk evaluators (Haught; see at least Abstract, column 1, line 65 to column 2, line 18, column 3, line 55 to column 4, line 60, column 7, lines 15-36); and

electronically transmitting said insurance profiles to said underwriters, wherein said underwriters or risk evaluators analyze the information in said insurance profiles for determining whether offers of insurance should be made to said one or more clients seeking insurance coverage (Haught; see at least Abstract, column 1, line 65 to column 2, line 18, column 3, line 55 to column 4, line 60, column 7, lines 15-36).

(B)   As per claims 2-8, Haught teaches a method as analyzed and discussed in claim 1 above

further comprising electronically transmitting the offers of insurance to the one or more agency locations in a proposal format presentable to the one or more clients seeking insurance (Haught; see at least Abstract, column 1, line 65 to column 2, line 18, column 3, line 55 to column 4, line 60, column 7, lines 15-36);

wherein the translating or formatting step includes reformatting the request depending on the insurance vendor (reads on conforming said information to standard terminology used in the insurance industry) (Haught; see at least Abstract, column 1, line 65 to column 2, line 18, column 3, line 55 to column 4, line 60, column 7, lines 15-36);

wherein the translating step includes supplementing the information with additional information (Haught; see at least column 1, line 65 to column 2, line 18, column 5, line 62 to column 6, line 4);

wherein the supplementing step includes accessing one or more third-party databases for obtaining the additional information (Haught; column 2, lines 52-62);

wherein the translating step includes limiting the information (reads on pre-screening said insurance profiles) before the step of electronically transmitting said insurance profiles to said underwriters (Haught; column 4, lines 10-25);

wherein the extracting step includes compiling a group of said insurance profiles, and wherein the information is limited (reads on at least one of said insurance profiles are removed from said group during the pre-screening step) (Haught; column 4, lines 10-25, column 6, lines 17-25);

wherein each said insurance profile includes information about types of insurance sought by said one or more clients seeking insurance coverage (Haught; column 3, lines 29-34, column 4, line 35 to column 5, line 8).

(C)   As per claims 9-15, Haught teaches a method as analyzed and discussed in claim 1 above

wherein each said insurance profile includes customer data pertinent to the desired policy (reads on client data and information about levels of insurance sought by said one or more clients seeking insurance coverage) (Haught; column 3, lines 29-34, column 4, line 35 to column 5, line 19);

wherein the extracting step occurs automatically without human intervention (Haught; see at least column 1, line 65 to column 2, line 18, column 2, lines 52-62, column 3, lines 29-33, column 4, lines 35-60, column 6, lines 26-48);

wherein the extracting step occurs periodically (Haught; see at least column 3, line 55 to column 5, line 19);

wherein the extracting step occurs at predetermined periods (reads on scheduled intervals) (Haught; see at least column 3, line 55 to column 5, line 19);

wherein the extracting step occurs selectively and in response to human intervention (Haught; see at least column 3, line 55 to column 5, line 19);

wherein the extracting step includes periodic renewal analysis (reads on identifying insurance policies that are scheduled to expire within a specified time period) and retrieving the insurance profiles associated with the identified insurance policies (Haught; see at least column 3, line 55 to column 5, line 19); and

wherein the extracting step includes identifying at least one of the one or more clients and retrieving the insurance profiles associated with the identified clients (Haught; see at least column 3, line 55 to column 5, line 19).

(D)   As per claims 19-23, 25 Haught teaches a method as analyzed and discussed in claim 1 above

further comprising electronically transmitting the extracted insurance profiles to a central computer or agency computer adapted to interface with the one or more underwriters or risk evaluators, wherein said central computer is adapted to perform the translating step (Haught; see at least Figure 5, column 1, line 65 to column 2, line 18, column 3, line 55 to column 4, line 60, column 7, lines 15-36);

wherein the extracted insurance profiles are electronically transmitted to the central

computer or agency computer in one or more formats, said central computer including a

processor capable of retrieving information from said insurance profiles and providing the

information into a format readable by said underwriters or risk evaluators (Haught; see at least

Abstract, Figure 5, column 1, line 65 to column 2, line 18, column 3, line 55 to column 4, line

60, column 7, lines 15-36);

wherein each said underwriter or risk evaluator has one or more computers in

communication with said central computer or agency computer for receiving the extracted

profiles so as to allow said underwriters or risk evaluators to evaluate the risk information

associated with the extracted insurance profiles (Haught; see at least Abstract, column 1, line 65

to column 2, line 18, column 3, line 55 to column 4, line 60, column 7, lines 15-36);

wherein said central computer or agency computer translates the information associated

with the extracted profiles into a format useable by said underwriters or risk evaluators for

assessing risks associated with the one or more clients seeking insurance coverage (Haught; see

at least Abstract, column 1, line 65 to column 2, line 18, column 3, line 55 to column 4, line 60,

column 7, lines 15-36);

wherein the proposal format presentable to the one or more clients seeking insurance is a

format selected from the group consisting of a printed format and a digital format (Haught; see at

least Abstract, column 1, line 65 to column 2, line 18, column 3, line 55 to column 4, line 60,

column 7, lines 15-36); and

wherein the step of electronically transmitting the offers of insurance includes

transmitting the offers of insurance to an insurance agent or customer service representative

(CSR) at the agency location, the method further comprising customizing one or more of the offers of insurance into a proposal having a format readable by at least one of the one or more clients (Haught; see at least Abstract, column 1, line 65 to column 2, line 63, column 3, line 36 to column 4, line 60, column 7, lines 15-36).

(E)   Claim 26 differs from claim 1 in that it is a system for generating insurance quotes rather than a method for automatically generating insurance quotes.

As per claim 26, Haught teaches a system for generating offers from vendors (reads on insurance quotes) comprising:

one or more agency computers for creating and storing insurance profiles for one or more clients seeking insurance coverage, wherein said one or more computers are in communication with an electronic database for storing the created insurance profiles (Haught; see at least Figure 1, Figure 3, Item 390, Abstract, column 1, line 65 to column 2, line 18, column 2, line 66 to column 3, line 34, column 3, line 55 to column 4, line 60, column 7, lines 15-36);

one or more underwriter or risk evaluator computers in communication with said one or more agency computers for receiving one or more of the insurance profiles, analyzing the received insurance profiles for assessing risk parameters associated with the one or more clients seeking insurance coverage, determining whether offers of insurance should be made to the one or more clients seeking insurance coverage, and electronically transmitting the offers of insurance to the agency computers (Haught; see at least Figure 1, Figure 3, Item 390, Abstract,

column 1, line 65 to column 2, line 18, column 2, line 66 to column 3, line 34, column 3, line 55

to column 4, line 60, column 7, lines 15-36); and

a central computer or DSTM in bi-directional communication with both said agency

computers and said underwriter or risk evaluator computers for translating said insurance

profiles into a format usable by said underwriter or risk evaluator computers and said agency

computers (Haught; see at least Figure 1, Figure 3, Items 380 and 390, Abstract, column 1, line

65 to column 2, line 18, column 2, line 66 to column 3, line 34, column 3, line 55 to column 4,

line 60, column 7, lines 15-36).

(F)   As per claims 27-28, 31, 34, Haught teaches a system as analyzed and discussed

in claim 26 above

wherein said central computer translates or reformats offers of insurance from said

underwriter computers into a format usable by said agency computers for creating or modifying

insurance proposals for the one or more clients seeking insurance (Haught; see at least Figure 1,

Figure 3, Items 380 and 390, Figure 5, Abstract, column 1, line 65 to column 2, line 18, column

2, line 66 to column 3, line 34, column 3, line 55 to column 4, line 60, column 5, line 62 to

column 6, line 4, column 7, lines 15-36);

wherein said central computer is in communication with one or more proprietary

databases for obtaining additional information used by said underwriter computers for

determining whether offers of insurance should be made to the one or more clients seeking

insurance coverage (Haught; see at least Figure 1, Figure 5, Abstract, column 1, line 65 to

column 2, line 18, column 2, line 52 to column 3, line 34, column 3, line 55 to column 4, line 60,

column 5, line 62 to column 6, line 4, column 7, lines 15-36);

wherein said types of insurance are selected from the group consisting of workers'

compensation, businessowner's policies, property, general liability, auto, inland marine, umbrella

and various personal lines policies (Haught; see at least column 4, lines 66 to column 5, line 8);

and

wherein said agency computers include a visual display adapted to present one or more

profile screens and a data entry device for creating insurance profiles on one or more clients

seeking insurance coverage (Haught; see at least column 3, lines 36-46).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the m3anner in which the invention was made.

8.   Claims 16-18, 24, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Haught, et al., U.S. Patent Number 6,584,467 as applied to claims 1 and 26 above, and further in

view of Libman, U.S. Patent Number 5, 987, 434.

(A)   As per claim 16, Haught teaches a method as analyzed and discussed in claim 1

above.

Haught fails to explicitly disclose a method wherein the extracting step includes identifying one or more types of insurance and retrieving the insurance profiles of the clients associated with the one or more types of insurance identified.

However, the above features are well-known in the art, as evidenced by Libman.

In particular, Libman teaches a method wherein the extracting step includes identifying one or more types of insurance and retrieving the prospective client information (reads on insurance profiles) of the clients associated with the one or more types of insurance identified (Libman, see at least column 5, lines 49-56, column 7, lines 34-57, column 8, lines 38-47).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Haught to include wherein the extracting step includes identifying one or more types of insurance and retrieving the insurance profiles of the clients associated with the one or more types of insurance identified, as taught by Libman, with the motivations of providing an apparatus and method for transacting marketing and sales which is capable of being highly automated, which is capable of processing relatively large volumes of client communications efficiently which are relatively cost effective compared to prior approaches and which are more personalized and individualized to individual prospective clients relative to prior approaches (Libman; column 3, lines 33-48).

(B)   As per claims 17-18, 24, 30 Haught and Libman teach a method as analyzed and discussed in claims 1 and 26 above

wherein the extracting step includes grouping the extracted prospective client information

(reads on insurance profiles) by type of insurance coverage sought by the one or more clients

(Libman; see at least Figure 10, Item B, column 15, lines 23-28);

wherein the extracting step includes grouping the extracted prospective client information

(reads on insurance profiles) by name of carrier (Libman; see at least Figure 10, Item B, column

15, lines 23-28);

wherein said format is selected from the group consisting of ASCII, delimited, XML,

HTML, AL3 and other electronic formats, such as are used on the Internet (Libman; see at least

Figure 2, column 7, line 34 to column 8, line 8); and

wherein said central computer includes a bi-directional universal translation protocol that

translates formats in the group consisting of ASCII, delimited, XML, HTML, AL3 and other

electronic formats such as are used on the Internet (Libman; see at least Figure 2, column 7, line

34 to column 8, line 8).

9.   Claims 29, 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Haught, et al., U.S. Patent Number 6,584,467 as applied to claim 26 above, and further in view

of Official Notice.

(A)   As per claim 29, Haught teaches a system as analyzed and discussed in claim 26

above.

Haught fails to explicitly disclose a system

wherein said agency computers utilize software applications selected from the group consisting typically of TAM, AfW, Sagitta, AMS Prime, DORIS, Agency Works, VRC, Instar, Ebix CD1 and Ebix CD2 and others.

However, the use of various software applications within computerized systems are well-known in the art.

Examiner takes official notice that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Haught to include wherein said agency computers utilize software applications selected from the group consisting typically of TAM, AfW, Sagitta, AMS Prime, DORIS, Agency Works, VRC, Instar, Ebix CD1 and Ebix CD2 and others with the motivation of obtaining information needed to render risk evaluative decisions from vendors in real time information that may be used for agents preparing insurance applications (Haught; see at least Abstract).

(B)   As per claims 32-33, Haught teaches a system as analyzed and discussed in claim 26 above.

Haught fails to explicitly disclose a system

wherein said agency computers are located at agencies and wholesalers and wherein said underwriter computers are located at underwriters, managing general agencies, managing general underwriters, insurance companies, carriers and wholesalers.

However, the locating of agency computers and underwriter computers at convenient points within a networked system is well-known in the art.

Examiner takes official notice that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Haught to include wherein said agency computers are located at agencies and wholesalers and wherein said underwriter computers are located at underwriters, managing general agencies, managing general underwriters, insurance companies, carriers and wholesalers with the motivation of using computer networks to gather information relevant to insurance-related decisions (Haught; see at least Abstract, column 1, lines 13-column 2, line 18).

Conclusion

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references Underwood et al., U.S. Patent Number 5, 873, 066 , Joao, U.S. Patent Number 6, 283, 761 , Lockwood, U.S. Patent Number 4, 567, 359, Diedrichsen et al., U.S. Patent Number 6,671,716, and Ryan, et al, U.S. Patent Number 6,684,189 teach the environment of generating and reformatting insurance quotes.

10.   Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

        or faxed to: **(703) 305-7687.**

For informal or draft communications, please

label "PROPOSED" or "DRAFT" on the front page of

the communication and do NOT sign the

communication.

After Final communications should be labeled

"Box AF."

Hand-delivered responses should be brought to Crystal

Park 5, 2451 Crystal Drive, Arlington, VA, Seventh Floor

(Receptionist).

11.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. The

examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The

examiner can also be reached on alternate Fridays.

12.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Thomas, can be reached at (703) 305-9588. Any inquiry of a general nature

or relating to the status of this application or proceeding should be directed to the Receptionist

whose telephone number is (703) 308-1113.

13.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Natalie A. Pass

November 16, 2004

ALEXANDER KALINOWSKI
PRIMARY EXAMINER